

I. Paragraphs 11-12: Double Patenting over Yates 6,397,379

Paragraphs 11-12 of the Office Action suggest an obviousness-type double patenting issue relative to Yates '379.

First, Applicant notes that the Office Action neglects nearly all of the showings required to raise an obviousness-type double patenting rejection. In order to raise an obviousness-type double patenting rejection, the MPEP requires the following:

- Identify at least one one-to-one pair of particular claims between the current application and the issued patent. For example, MPEP § 804(B)(1) instructs that when making an obvious-type double patenting analysis, the following factual inquiries must be set forth:
 - (A) Determine the scope and content of a patent claim [singular] and the prior art relative to a claim [singular] in the application at issue;
 - (B) Determine the differences between the scope and content of the patent claim [singular] and the prior art as determined in (A) and the claim [singular] in the application at issue;

The Office Action makes no showing of how any one of the 64 claims of the current application correspond to any single one of the 47 claims of the '379 patent. Until a particular claim of this application is shown to attempt to "patent" something already "patented" by a particular claim of the '379 patent, or an obvious variant thereof, there can be no double patenting, and no rejection is warranted.

- Identify the difference between the pairs of claims. The Office Action sets out only a very imprecise comparison of claim 1 of this application to claim 8 of the '379 patent, and no comparison whatsoever of any other claim.
- Once that difference is identified, make the three showings set out at MPEP § 2143-2143.03 to establish *prima facie* obviousness: (a) motivation to modify or combine, (b) reasonable expectation of success, and (c) every element known in the prior art. The Office Action makes no such showings.

Without those showings, Applicant cannot meaningfully respond. When a rejection is not stated with sufficient specificity to permit a response, no rejection exists.

Second, the Office Action compares the claims of this application to claims which do not even exist in the '379 patent. For example, claims of this application are compared to "4+7" and "4+8" of the '379 patent. But neither 7 nor 8 depends on claim 4! There is no basis to combine these claims. If there is no claim, there is no "patenting" in the '379 patent, and no "double patenting" here. Similarly, the Office Action reads limitations out of the independent claims of the '379 patent - the Office Action fails to consider whether these limitations are non-obvious

over the claims of this application. It is improper to base a rejection on "imaginary" claims of the '379 patent. No rejection exists.

Third, Applicant notes that insufficient care was exerted to raise a *bona fide* rejection. For example, the independent claims of this application recite limitations that are not recited in the independent claims of '379:

- claims 1, 2 and 14: "a device with a valid memory address that cannot be guaranteed to be well-behaved"
- claim 22 and similar language in claim 30: "while translating ... a binary representation of a program ..., distinguishing individual memory loads that are believed to be directed to well-behaved memory from memory loads that are believed to be directed to non-well-behaved memory device(s)"
- claim 44, and similar language in claim 55: "detecting a side-effect about to be committed to processor state in which the differing side-effect sequence may have a material effect on the execution of the program, and aborting the side-effect"

In turn, each of the independent claims of the '379 patent recite limitations that are absent from the claims of this application. Because these limitations are not even mentioned in the Office Action, no rejection exists.

Fourth, much of the analysis in the Office Action is inconsistent with facts already conceded by the Examiner. For example, claims 1-39 recite an event that occurs or action that is taken "based at least in part on an annotation encoded in a segment descriptor." The Office Action asserts that this is "inherent." The Office Action is incorrect in three respects:

- a) the Office Action does not make the showing required by MPEP § 2112(IV) ("in relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning [to show] that the allegedly inherent characteristic necessarily flows..."). Without that "basis in fact and/or technical reasoning," there is no inherency, and no rejection.
- b) The Examiner appears to have already conceded that Cmelik '992 teaches an alternative to a "segment descriptor." Therefore this limitation does not "necessarily flow," and therefore is not inherent.
- c) The Examiner has already conceded that the "segment descriptor" of these claims provides a non-obvious distinction over Cmelik '992. The Office Action provides no basis to now assert the opposite, that "segment descriptors" are "obvious" over the claims of Yates '379.

For four separate reasons, no double patenting rejection has been raised over Yates '379.

No terminal disclaimer is warranted.

II. Paragraph 13: Double Patenting over Yates 6,789,181

Paragraph 13 of the Office Action is not clear. U.S. Patent No. 6,789,394 is not co-owned, and therefore there can be no double patenting. No rejection has been raised.

In an effort to advance prosecution, Applicant offers the following observations vis-à-vis U.S. Patent No. 6,789,181.

As noted above, any obviousness-type double patenting rejection requires at least these showings:

- Identify at least one-to-one pair of particular claims between the current application and the issued patent. It is not clear how any one of the five claims of the current application corresponds one-to-one to any one of the ten claims of the Yates '181 application listed in paragraph 13.
- Compare individual claims of the '181 patent to the claims of this application to identify the difference. The Office Action makes no such comparison or identification.
- Show *prima facie* obviousness as set forth in MPEP § 2143-2143.03. The Office Action makes no such showings.

Because the Office Action sets out no reasoning in support of any required step, the minimum requirements for raising a double-patenting rejection have not been met.

In an effort to advance prosecution, applicant notes that each of claims 1, 14, 22, 30, 42 recite something that occurs "based at least in part on an annotation encoded in a segment descriptor." None of the identified claims of the Yates '181 patent recite a "segment descriptor." Claims 1, 14, 22, 30, 42 cannot be "obvious" when they recite limitations absent from the Yates '181 claims.

In view of the amendments and remarks, Applicant respectfully submits that the claims are in condition for allowance. Applicant requests that the application be passed to issue in due course. The Examiner is urged to telephone Applicant's undersigned counsel at the number noted below if it will advance the prosecution of this application, or with any suggestion to resolve any condition that would impede allowance. In the event that any extension of time is

FROM WILLKIE FARR 37 FAX DEPT

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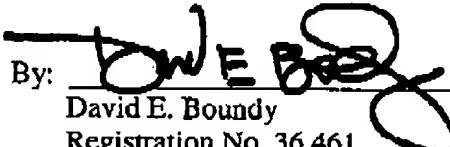
Amendment Dated February 28, 2005 - Response to Office Action of December 30, 2004

required, Applicant petitions for that extension of time required to make this response timely.
Kindly charge any additional fee, or credit any surplus, to Deposit Account No. 23-2405, Order
No. 114596-20-4009.

Respectfully submitted,

WILLKIE FARR & GALLAGHER LLP

Dated: February 28, 2005

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